



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/362,052	07/28/1999	YOICHI MATSUYAMA	35.C13703	6357

5514 7590 03/08/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HU, JINSONG

ART UNIT	PAPER NUMBER
----------	--------------

2154

14

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/362,052

Applicant(s)

MATSUYAMA ET AL.

Examiner

Jinsong Hu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-38 are presented for examination. Claims 1-10, 12, 16, 18-19, 21-22, 25 and 27-37 have been amended; claim 38 is a newly added claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-14, 16-23 and 25-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuyama (US 6,330,068 B1).

4. As per claims 1 and 3, Matsuyama teaches the invention substantially as claimed including an information processing apparatus [103, Fig. 1] for communicating via the Internet with an external apparatus [104, Fig. 1; col. 7, lines 15-21], comprising:

acquisition means for acquiring print setting information from the external apparatus [col. 7, lines 34-36], and storing print setting information in a memory [col. 7, lines 34-36; col. 11, lines 48-50];

page generation means for generating a print request page based on the print setting information acquired by said acquisition means and a preview image of print

Art Unit: 2154

data that is currently being edited [col. 2, lines 28-36; col. 3, lines 44-51; col. 39, lines 10-17];

file generation means for generating a print request file according to values input on the print request page [col. 11, lines 25-34]; and

print request means for establishing communication with the external apparatus to send the generated print requested file [col. 39, lines 5-9].

5. Matsuyama does not specifically teach that the print request page is generated before the communication with the external apparatus is established by the print request means. However, it would have been obvious to a person of ordinary skill in the art that finalized the print request before connecting the external apparatus since the information processing apparatus in Matsuyama's system stored the information for operating the printers. One of ordinary skill in the art would have been motivated to modify Matsuyama's system to improve the efficiency of the system by avoiding retrieve the information that is available at the local terminal.

6. As per claim 2, Matsuyama teaches that the print setting information is the information indicates an output style in which output is available at a printer that executing printing based on the print request information [col. 7, lines 34-36; col. 11, lines 48-50].

7. As per claims 4-5 and 38, Matsuyama teaches the invention substantially as claimed in claim 1. Matsuyama also teaches the step of deriving the expenses that are to be incurred to obtain the printing results [payment, Fig. 6]. However, Matsuyama does not specifically teach the steps of updating the setting information and expense information after establishing communication with said external apparatus. It would have been obvious to a person of ordinary skill in the art that to retrieve the latest system information in Matsuyama's system in order to provide the accurate information to users. One of ordinary skill in the art would have been motivated to modify Matsuyama's system to improve the integrity of the system.

8. As per claim 7, Matsuyama teaches that the page generating means performs a peruser plug-in function, and uses an application communication function of an operating system to generate the print request page of a document that is currently being edited by a document editor [101, Fig. 1; col. 10, lines 31-43].

9. As per claim 8, Matsuyama teaches that a dial-up connection is used to connect the external apparatus to the Internet [col. 7, lines 20-21].

10. As per claims 9 and 29-31, Matsuyama teaches second acquisition means for acquiring a template file separately from the print setting information, wherein the print setting file is generated with reference to the template file [col. 10, lines 31-44].

Art Unit: 2154

11. As per claims 10-14, 16-18 and 32-34, since they are method claims of claims 1-5, 7-9 and 29-31, they are rejected under the same basis as claims 1-5, 7-9 and 29-31.

12. As per claims 19-23, 25-27 and 35-37, since they are computer program claims of claims 1-5, 7-9 and 29-31, they are rejected under the same basis as claims 1-5, 7-9 and 29-31.

13. As per claim 28, since it is a computer program claim of claim 1, it is rejected under the same basis as claim 1.

14. Claims 6, 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuyama (US 6,330,068 B1) in view of Sasaki et al. (US 6,351,317 B1).

15. As per claim 6, Matsuyama teaches the invention substantially as claimed in claim 1. However, Matsuyama does not specifically teach that the print setting information is HTML data generated for the external apparatus, and said external apparatus manages the print setting information for each of at least one output shop.

16. Sasaki on the other hand teaches a method discloses that the print setting information is HTML data generated for the external apparatus, and wherein the external apparatus manages the print setting information for each of at least one output shop [col. 15, lines 8-43]. It would have been obvious to a person of ordinary skill in the

Art Unit: 2154

art at the time the invention was made to combine the teaching of Matsuyama/Shiota and Sasaki because utilizing Sasaki's HTML format print setting information in the combination system of Matsuyama and Shiota would improve the capability of the combination system by allowing user printing the desired web page. One of ordinary skill in the art would have been motivated to modify the combination system of Matsuyama and Shiota with HTML format setting information in order to improve the capability of the system.

17. As per claim 15, since it is a method program claim of claim 6, it is rejected under the same basis as claim 6.

18. As per claim 24, since it is a computer program claim of claim 6, it is rejected under the same basis as claim 6.

Conclusion

19. Applicant's arguments with respect to claims 1-38 for reference Shiota are moot in view of the new ground(s) of rejection.

20. Applicant's arguments filed on 12/15/03 for claims 1-38 for references Matsuyama and Sasaki have been fully considered but they are not deemed to be persuasive.

In the remarks, applicant argued in substance that (1) Matsuyama does not teach a print page is generated without connecting to an external apparatus based on the stored print information and a preview image of print data that is currently edited and then being transferred to the external apparatus for printing; (2) Sasaki does not teach generating a print request page based on stored print information without connecting the external apparatus.

21. Examiner respectfully traverses applicant's remarks:

A. As to point (1), Examiner has explained the reason of rejection; see corresponding paragraphs in this office action for details.

B. As to point (2), Examiner cited Sasaki as a prior art reference for teaching the step of generating HTML format print setting information, because including this function to Matsuyama's system would improve the functionality of the system. Examiner does not specify this reference teaches generating a print request page based on stored print information without connecting the external apparatus as applicant argued.

Accordingly, Matsuyama and Sasaki are relevant prior art references.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee, can be reached on (703) 305-8498. The fax number for this Group 2100 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

February 26, 2004



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100